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In re Application of
KRAH et al. : DECISION ON
Application No.: 10/581,929 :
PCT No.: PCT/EP2004/012649 : PAPERS
Int. Filing Date: 09 November 2004 :
Priority Date: 24 November 2003 : UNDER 37 CFR 1.42
Attorney's Docket No.: None :
For: DEVICE AND METHOD FOR
MANUFACTURING WRAPPED TUBES :

This is a decision on the submission filed by applicants on 08 November 2006, which was accompanied by, *inter alia*, two declarations of the inventors. The indication in the second declaration that inventor Adolf Berger is deceased has been treated as a request for status under 37 CFR 1.42.

BACKGROUND

On 09 November 2004, applicants filed international application PCT/EP2004/012649 which designated the U.S. and claimed a priority date of 24 November 2003. A copy of the international application was communicated to the United States Patent and Trademark Office (USPTO) from the International Bureau on 16 June 2005. The thirty-month period for paying the basic national fee in the United States expired at midnight on 24 May 2006.

On 07 June 2006, applicants filed a transmittal letter for entry into the national stage in the United States, which was accompanied by, *inter alia*, the Basic National Fee, an assertion of small entity status, the surcharge under 37 CFR 1.492(h) for filing any of the search fee, the examination fee, or the oath or declaration after the date of the commencement of the national stage, an English translation of the international application, and a petition under 37 CFR 1.137(b) to revive the application.

On 14 August 2006, a decision was mailed granting applicants' petition under 37 CFR 1.137(b).

On 30 October 2006, the United States Designated/Elected Office (DO/EO/US) mailed a NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 (Form

PCT/DO/EO/905) indicating, *inter alia*, that an oath or declaration in compliance with 37 CFR 1.497(a)-(b) was required.

On 08 November 2006, applicants filed the instant submission which was accompanied by, *inter alia*, two declarations of the inventors. The indication in the second declaration that inventor Adolf Berger is deceased has been treated as a request for status under 37 CFR 1.42.

On 27 December 2006, the DO/EO/US mailed a NOTIFICATION OF DEFECTIVE RESPONSE (Form PCT/DO/EO/916) indicating that the declaration of inventors filed 08 November 2006 was missing the signature of Adolf Berger.

DISCUSSION

The NOTIFICATION OF DEFECTIVE RESPONSE mailed 27 December 2006 was mailed in error (i.e., applicant's request under 37 CFR 1.42 had not been taken into account) and is hereby VACATED.

The declaration signed by Karl-Heinz Krah fails to comply with 37 CFR 1.497(a)-(b) because it does not identify all of the inventors. Each executed declaration must identify all of the inventors and the citizenship of all of the inventors. Also, each submitted declaration must be complete, even if executed by only one of the inventors. Also, the declaration signed by Karl-Heinz Krah indicates an incorrect filing date for the international application; the declaration indicates the date as 09 December 2004 whereas the actual date is 09 November 2004.

The declaration signed by Kathe Berger also fails to comply with 37 CFR 1.497(a)-(b). The declaration fails to state that the person making the oath believes the named inventors (both Adolf Berger and Karl-Heinz Krah) to be the original and first inventors of the subject matter which is claimed and for which a patent is sought.

The submission of the declaration executed by the sole heir is hereby construed as an indication that no legal representative of the deceased's estate has been appointed and that no legal representative is required by the applicable law to be appointed and thus the sole heir is signing as the legal representative of the estate. If this interpretation is incorrect application is required to promptly notify the Office of such and to submit a declaration properly executed by the legal representative of the deceased inventor in response to this decision.

CONCLUSION

For the above reasons, the request for status under 37 CFR 1.42 is **REFUSED**.

The NOTIFICATION OF DEFECTIVE RESPONSE mailed 27 December 2006 is **VACATED** for the reasons set forth above.

Please direct further correspondence with respect to this matter to Mail Stop PCT,

Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

Applicant is required to submit a declaration in compliance with 37 CFR 1.497 and 1.42 within a time period of **TWO (2) MONTHS** from the mail date of this Decision. THIS PERIOD FOR RESPONSE MAY BE EXTENDED UNDER 37 CFR 1.136(a). FAILURE TO PROPERLY RESPOND WILL RESULT IN ABANDONMENT. Any request for reconsideration of this decision should include a cover letter entitled "Renewed Submission Under 37 CFR 1.42."



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